

REMARKS

A. Introduction

Claims 1-18 were presented for examination.

Claims 1-18 were rejected.

Claim 8 was amended to correct a clerical error.

B. Introductory Remarks

Applicants are currently prosecuting two divisional patent applications directed to "Ultra Fine Dead Sea Mineral Compound and Method of Manufacture." These divisional applications are directed to (1) a method of manufacturing cosmetic preparations (Serial No. 10/601,795) and (2) an anhydrous chemical composition for application to the skin (Serial No. 10/601,796).

In response to Examiner's final Office Action for Serial No. 10/601,795 (the method), dated December 29, 2004, the undersigned attorney initiated a telephone conference with Examiner which occurred on January 27, 2005 at 10:00 a.m. CMT. At this time, no office action had been issued for Serial No. 10/601,796 (the composition).

The undersigned attorney pointed out discrepancies between Examiner's December 29, 2004 Final Office Action and her previous Office Action dated August 18, 2004. One such discrepancy was that Examiner mistakenly included Claim 3 in a § 103 rejection in the December 29, 2004 Office Action, but in her previous Office Action dated August 18, 2004, she had rejected Claim 3 under § 102. Examiner admitted this was a mistake.

Regarding U.S. Patent No. 6,458,388 to Genis et al (Genis), Examiner indicated that her position was that the limitation "all-natural carrier medium" in Claim 3 in the

present invention read on both aqueous and non-aqueous phases. Examiner indicated that in order to overcome the Genis reference, Applicants needed to include the term “anhydrous” in their claims. Further, Examiner suggested amending the “all-natural carrier medium” limitation in Claim 3 to read “all-natural carrier medium being an oil.”

Regarding EP 1074245 (EP ‘245), Examiner readily admitted that this reference did not teach high concentrations of Dead Sea salt. Examiner also indicated that Applicants would be able to overcome the EP ‘245 reference simply by amending their claim to reflect “50% by weight of total composition.” Examiner’s position was that, although Applicants’ specification supported the inclusion of more than 50% processed ultra fine Dead Sea mineral salts, the claims did not. Amending the claims in this way, Examiner contended, would overcome the EP ‘245 reference. Having overcome Genis and EP ‘245, U.S. Patent No. 5,997,889 to Durr et al (the Durr reference) automatically disappeared.

Finally, Examiner requested Applicants submit comparative data in support of Applicants’ claims. Specifically, Examiner requested comparison studies between two compositions: (i) using an aqueous medium, (ii) the other, using a non-aqueous medium (oil based).

Because the December 29, 2004 Office Action was a Final Office Action, Examiner indicated Applicants would need to file a Request for Continued Examination (RCE) with their Response, incorporating Examiner’s suggestions. Examiner further indicated that these suggestions should also be followed for Serial No. 10/601,796 (the composition) which she had yet to mail out. She indicated she had or would finally reject

those claims as well. Applicants did as Examiner suggested. However, despite Applicants' full compliance, Examiner continues to maintain her rejections.

C. Claims 1-5, 7-10, 16 and 18 Rejected Under 35 U.S.C. § 103

Examiner rejected Claims 1-5, 7-10, 16, and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 2003/0211062 to Laden et al (Laden) in view of KR 149428 to Lee et al. (KR). Claim 8 was amended to correct a clerical error. Applicant considered Examiner's rejections and respectfully disagrees.

Examiner bears the initial burden of establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be some reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not be based on applicant's disclosure. Manual of Patent Examining Procedure (M.P.E.P. § 2142); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Examiner failed to establish a *prima facie* case of obviousness.

1. Teaching or Suggestion of All Claim Limitations

To establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1296 (Fed. Cir. 1988);

M.P.E.P. § 2143.03. The prior art references do not teach or suggest all of the claim limitations.

Laden discloses an anhydrous skin cleanser gel. However, while Laden discloses using Dead Sea salts as one of many crystalline abrasive materials, Laden does not teach the limitation of Claim 1 that the Dead Sea salts are “processed.” Further, Laden only discloses Dead Sea salts in concentrations of significantly less than 50% on a weight % basis. Specifically, Examples 1 and 8 show the percent by weight of Dead Sea salts as 30.4% and 31%, respectively. Clearly then, Laden fails to teach the limitation of “at least 50% by weight of total composition of the processed Dead Sea mineral particles” as recited in Claim 1.

While disclosing where Dead Sea salts can be commercially obtained, *i.e.*, Dead Sea Works, Ltd. at [0035], Laden fails to disclose the range of granularity sizes associated thereto. Nowhere in the Laden reference is there disclosure of the granularity sizes concerning Dead Sea salts per se. In fact, Laden expressly indicates that “the Dead Sea Salts are generally heterogeneous mixtures of crystalline and powder mineral salts.” [0034](emphasis added).

In contrast, Applicants expressly disclosed the two (2) standard size granularity grades of commercially available Dead Sea salts as “90% less than 1.7 mm” (Specification, Page 13, lines 9-10) and “greater than 90% between 1.7 mm and 4.0 mm.” (Specification, Page 13, lines 12-13).

Moreover, Applicants clearly contrast these standard grade granularity sizes with the processed ultra fine minerals of the present invention. (Specification, Page 13, line 13 through Page 14, line 6). Processing is a crucial element of the present invention not

found in Laden.

Cosmetic compositions containing all natural ingredients are desirable. The emollient oils that Laden includes as its medium carrier include, *inter alia*, silicone oils. [0019], [0022]. Silicone oil is a synthetic that can clog the skin. In contrast, “the carrier medium of the present invention contains all natural ingredients and is non-comedogenic,” *i.e.*, does not clog pores. (Specification, Page 9, lines 11-13). Laden thus fails to teach the limitation of “a continuous all-natural carrier medium” as recited in Independent Claim 1.

Further, while Laden may disclose palm oil, soybean oil, olive oil, jojoba oil, coconut oil and Vitamin E oil, these oils are not contained in an “all-natural carrier medium” as recited in dependent Claims 2-5, and 9-10. Further still, Laden does not disclose the limitations of “continuous all-natural carrier medium comprises jojoba wax,” as recited in Claim 7, and “continuous all-natural carrier medium comprises cashew husk oil ethoxylate,” as recited in Claim 8.

KR discloses a cosmetic composition comprising 15-85% by weight of bay salt, Dead Sea salt, or bamboo salt. However, while KR discloses a particle size in the range of 0.01 mm- 5.0 mm, no indication is given as to which one of the three salts is used as a given particle size. It may be possible to have a particle size of 0.01 mm of, for example, bay salt or bamboo salt. However, if Dead Sea salts were used, then the particle size would necessarily be in the range of either 90% less than 1.7 mm or greater than 90% between 1.7 mm and 4.0 mm size granularity, as those are the particle sizes of the two standard grades of native Dead Sea mineral particles that are commercially available, as indicated in the present invention (Specification, Page 13, lines 8-13) and discussed

above.

There is also no indication in KR that any sort of processing occurs prior to using the salts in the composition. In contrast, the Dead Sea salts in the present invention undergo a vigorous particle size reduction process which eliminates impurities, leaving ultra fine minerals that are essentially “rock-free.” (Specification, Page 12, line 9 through Page 13, line 3). Indeed, Applicants have already received two (2) patents (U.S. Patent No. 6,607,151, August 19, 2003, and U.S. Patent No. 6,871,805, March 29, 2005) relating to the processing of Dead Sea minerals.

Therefore, although the range disclosed is between 0.01 mm – 5.0 mm, without the present invention, particle sizes of 100% less than 10 mesh and 100% less than 1.0 mm cannot be achieved when dealing with Dead Sea salts. Thus, KR fails to teach the limitation of “at least 50% by weight of total composition of processed Dead Sea mineral particles,” as recited in Independent Claim 1.

KR also does not teach the limitation “processed Dead Sea mineral particles in a continuous all-natural carrier medium being an oil,” as recited in Claim 1. KR instead teaches a medium being a polyol. (see below).

KR also does not teach the limitations of “continuous all-natural carrier medium comprises palm oil,” (Claim 2); “continuous all-natural carrier medium comprises soybean oil,” (Claim 3); “continuous all-natural carrier medium comprises olive oil,” (Claim 4); or “continuous all-natural carrier medium comprises jojoba oil.” (Claim 5).

KR further fails to disclose the limitations “continuous all-natural carrier medium comprises jojoba wax,” (Claim 7); “continuous all-natural carrier medium comprises cashew husk oil ethoxylate,” (Claim 8); “continuous all-natural carrier medium

comprises coconut oil,” (Claim 9); and “Vitamin E oil,” (Claim 10).

Finally, neither Laden nor KR teach the limitation “processed Dead Sea particles are less than about 10 mesh and less than about 1.0 mm size granularity,” as recited in Claim 16, or the limitation “[p]rocessed Dead Sea minerals, 100% of said processed Dead Sea minerals comprising granularity of less than about 10 mesh and less than about 1.0 mm size granularity,” as recited in Independent Claim 18. These limitations are nowhere to be found in either reference.

Neither Laden alone nor in combination with KR teach or suggest all of the claim limitations of the present invention. Examiner improperly rejected Claims 1-5, 7-10, 16 and 18.

2. Non-Analogous Art

To rely on references under 35 U.S.C. § 103, the references must be analogous prior art. M.P.E.P. § 2141.01(a). In order to rely on a reference as a basis for a rejection of an applicant’s invention, the reference must be either in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992).

Laden and KR are not analogous to the present invention. Laden teaches an anhydrous skin cleanser gel, which, while disclosing Dead Sea salts, does so in a synthetic environment, *i.e.*, many ingredients are not “all natural.” Natural ingredients are ingredients obtained from nature as opposed to being produced synthetically. (Specification, Page 9, lines 7-9). The Laden composition simply does not fall under an “all natural” category.

KR teaches an oil-in-polyol emulsion that uses oil and polyol as a polar solvent. (Page 3). A polyol, also known as a sugar alcohol, is a hydrogenated form of carbohydrate, whose carbonyl group has been reduced to a primary or secondary hydroxyl group. In other words, a polyol is a hydrocarbon with a number of alcohol functional groups. While technically water-free, the hydroxyl group functions almost like water. While the hydrocarbon backbone of a polyol would ordinarily not dissociate the salt into its respective ions, it is the presence of these strong electron-pulling hydroxyl groups that dissociate and pull the salts into solution. The more hydroxyl groups present, the greater the electron affinity, the more the polyol behaves like water.

In contrast, on the other side of the spectrum is the present invention. The present invention uses oil as its all-natural carrier medium and continuous phase. This oil is both anhydrous and non-polar. It is also comprised of all natural ingredients. Unlike a medium with water-like qualities (KR), there are no electron-pulling characteristics in oil. The highly ionic Dead Sea minerals cannot be dissolved in oil, adhering to the general principal of chemistry that “like dissolves like.” The minerals are in suspension and remain so in granular form due to the present invention’s novel technique of fractionalization of the Dead Sea minerals into an ultra fine mineral compound. (Specification, Page 12, lines 9-21). Just as regular table salt will remain in granular form when placed into cooking oil, so too do the Dead Sea minerals remain in their granular form when placed into the all-natural carrier medium oil of the present invention.

Clearly, the difference between synthetic ingredients used to make up the Laden carrier medium and the polyol-based medium in KR, on the one hand, and the all-natural

carrier medium oil in the present invention, on the other hand, are distinguishable features between the present invention and the two cited references. Laden and KR are simply not analogous to the present invention.

Furthermore, it is clear that KR emphasizes bamboo salt. Although KR recites Dead Sea salt, bay salt, and bamboo salt, the entire patent predominantly discusses bamboo salt. Indeed, bamboo salt, not Dead Sea salts, was what was tested and used in KR's comparative analysis. (See Tables 1-6). This is crucial as the composition of Dead Sea minerals is very unique. (Specification Page 7, line 21- Page 8, line 1). Dead Sea salts clearly do not have the same chemical composition as the other salts, including bay salt and bamboo salt. Therefore, KR fails entirely to provide adequate disclosures regarding the subject pertaining to Dead Sea minerals, providing further confirmation that KR is not analogous to the present invention.

3. No Suggestion to Combine References

Nowhere in the cited references is there any suggestion to dramatically increase the concentration of Dead Sea salts of a specific granularity size in an all natural anhydrous cosmetic composition. Indeed this cannot be done and Examiner fails to point to any reference to the contrary.

Therefore, there is simply no suggestion in KR to combine its increased level of Dead Sea salts with granularity size as high as 5.0 mm in a polyol based emulsion with the anhydrous synthetic composition in Laden to come up with the present invention. Such combination would not give the expected result of achieving the desired effects of a significantly high concentration of processed ultra fine Dead Sea mineral particles comprising granularity of less than 10 mesh and less than about 1.0 mm size granularity,

suspended in an all natural oil based carrier medium with improved relaxation from aromatic agents. Examiner improperly rejected Claims 1-5, 7-10, 16, and 18.

D. Claims 6, 11-15 and 17 Rejected Under 35 U.S.C. § 103

Examiner rejects Claims 6, 11-15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 2003/0211062 to Laden et al (Laden) in view of KR 149428 to Lee et al. (KR) as applied to claims 1-10, 16 and 18 above, in further view of U.S. Patent No. 5,997,889 to Durr et al (Durr). Applicants' Response to Office Action of August 18, 2004 and Applicants' Response to Office Action of February 2, 2005 are incorporated by reference herein. Applicants considered Examiner's rejections and respectfully disagree.

1. Teaching or Suggestion of All Claim Limitations

Laden simply does not teach any of the limitations of the dependent claims that Examiner rejected under this section. Specifically, Laden fails to teach or suggest the limitation "continuous all-natural carrier medium comprises beeswax," as recited in Claim 6. Laden also fails to disclose the limitation of "an essential oil blend," as recited in Claim 11. Laden further fails to disclose the limitations of "essential oil blend comprises lavender," as recited in Claim 12, "rosewood" as recited in Claim 13, "chamomile" as recited in Claim 14, and "calendula" as recited in Claim 15. Finally, Laden fails to teach the limitation "essential oil blend comprises lavender, rosewood, chamomile, and calendula," as recited in Claim 17. As Examiner correctly noted, Laden fails to disclose each of these limitations.

KR fails to teach the limitation of "an essential oil blend," as recited in Claim 11. KR further fails to disclose the limitations of "essential oil blend comprises lavender," as recited in Claim 12, "rosewood" as recited in Claim 13, "chamomile" as recited in Claim

14, and “calendula” as recited in Claim 15. Finally, KR fails to teach the limitation “essential oil blend comprises lavender, rosewood, chamomile, and calendula,” as recited in Claim 17. Like with Laden, these limitations are not found in KR.

Examiner removed the Genis reference only to replace this one reference with two other references that are even further removed from the present invention. Examiner simply fails to cite any reference, either alone or in any combination, that includes all of the claimed limitations of the present invention. Examiner improperly rejected Claims 6, 11-15, and 17.

2. Non-Analogous Art

Laden is an anhydrous skin cleanser gel which uses synthetic ingredients. KR is a polyol based composition and has water-like qualities. Durr even teaches that water may be used in the preparation of its composition (Col. 4, lines 24-28). In contrast, the present invention teaches an anhydrous composition which uses only all natural ingredients with an all natural carrier medium being an oil.

The use of Dead Sea minerals varies dramatically in each cited reference. The Dead Sea salts used in Laden are limited to 31% by weight of total composition. While KR discloses Dead Sea salts and 15%-85% of a “salt,” KR fails to show that any of these “salts” are Dead Sea salts or that processing is performed on the Dead Sea mineral salts prior to their use in the composition. Finally, Durr does not even contain any Dead Sea mineral salts.

The whole point of the present invention is to dramatically increase the concentration of Dead Sea minerals that can be introduced and remain in an all natural cosmetic composition for ultimate absorption into the human skin. This is not shown in

any of the cited references.

3. Suggestion to Combine References

Laden does not suggest the use of ultra fine Dead Sea mineral particles suspended in an all natural carrier medium. Further, KR fails to suggest the use of processed ultra fine Dead Sea salts, or the use of an oil-based carrier medium. There is no suggestion in Durr to combine the fragrances and essential oil with ultra fine Dead Sea mineral particles. Moreover, there is no suggestion to even use Dead Sea salts in Durr.

There is simply no obvious suggestion to combine these references to come up with the claimed invention, whether using the initial Laden reference or ultimately all three references cited by the Examiner. Therefore, there would not be any reasonable expectation of success to modify or to combine the compositions claimed in these prior art references to choose an appropriate oil containing Dead Sea salts of a particular granular size so as to provide the desired emolliency of the present invention in an all natural environment. Examiner's rejection of Claims 6, 11-15, and 17 are improper.

E. Applicants' Reply to Examiner's Response to Arguments

Examiner contends that the unexpected results and the Declaration of Terrance C. Clifford submitted pursuant to 37 C.F.R. § 1.132 were not persuasive. Examiner further contends new grounds of rejection. Examiner further contends that a careful analysis of the unexpected results reveals that the results presented are not of the same scope of the instant claims. Applicants respectfully disagree.

Examiner removed the Genus reference and replaced it with two additional references: Laden and KR. This only served to weaken, not strengthen, Examiner's argument supporting obviousness.

Examiner states that “while instant claims recite at least 50% of the Dead Sea salts, the results show that the skin feel and intended effect on the skin does not necessarily occur above 50% of the Dead Sea salts.” (Page 4)

Examiner also acknowledges that a concentration of 55% “is at least 50% as claimed.” However, Examiner continues by stating that at this concentration, the composition “still shows an unacceptable feel and the immediate effect is not intended.” (Page 4).

Examiner completely misses the obvious. At a concentration of 55% Dead Sea salts, all of the processed Dead Sea salts remain in suspension with no separation. This is clearly indicated in the results portion of Experiment 5. It is undeniable that the comparison data accompanying the Declaration unequivocally demonstrates a cosmetic composition comprising at least 50% by weight of total composition of processed Dead Sea mineral particles, having a size of less than about 10 mesh and stably suspended in an all-natural medium carrier.

Examiner also gives no basis for her “observation” that “at a concentration of 51%, the effect of Dead Sea salt is not uniform in all the samples and varies with the amount of soybean oil, jojoba oil, beeswax, and vitamin E oil (mixed tocopherols).” (Page 4-5). At concentrations of at least 50%, the Dead Sea salts remain in suspension. Therefore, the effect of Dead Sea salt is uniform in all the samples and does not vary as Examiner contends. Concentration is the key. The high concentrations of Dead Sea salt allow a consumer to enjoy elevated levels of the beneficial properties of a cosmetic composition rich in Dead Sea minerals.

Further, the qualitative characteristics noted by the Examiner cannot be attributed solely to the concentrations of soybean oil, jojoba oil, beeswax, and vitamin E oil (mixed tocopherols). Indeed, contrary to Examiner's "observation" of varying amounts, vitamin E oil (mixed tocopherols) remained constant at 0.05% throughout each experiment. Moreover, all the ingredients together play a role in the overall feel, appearance, and ability of the Dead Sea salts to remain in suspension without separation. Therefore, the Declaration is commensurate with the claimed invention.

Finally, as clearly shown in all experiments wherein the processed ultra fine Dead Sea minerals comprised at least 50% of the composition (Experiments 4-10), all Dead Sea salt minerals remained in suspension. (only Experiment 4 exhibited slight separation). Therefore, consistent results occur over the entire claim range of at least 50%. See M.P.E.P. 716.02(d); see also *In re Clemens*, 622 F.2d 1029, 1036, 206 U.S.P.Q. 289, 296 (C.C.P.A. 1980).

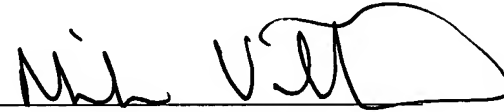
CONCLUSION

In view of the above, Applicants submit that Claims 1-18 are in condition for allowance. Applicants respectfully request reconsideration and withdrawal of the rejections and objections. Allowance of Claims 1-18 at an early date is solicited.

If Examiner still finds impediments to allow Claims 1-18 and, in the opinion of the Examiner, a telephone conference between the undersigned and Examiner would help remove such impediments, the undersigned respectfully requests such a telephone conference.

Respectfully submitted,

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